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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,114	10/25/2000	Toru Kobayashi	00745/LH	4404
1933	7590	04/18/2005	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 767 THIRD AVENUE 25TH FLOOR NEW YORK, NY 10017-2023			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/696,114

**Applicant(s)**

KOBAYASHI ET AL.

**Examiner**

Calvin L Hewitt II

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 124, 126-128, 130-137, 139-142, 144, 145 and 147-171 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 124, 126-128, 130-137, 139-142, 144, 145, and 147-171 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Status of Claims***

1. Claims 124, 126-128, 130-137, 139-142, 144, 145, and 147-171 have been examined.

***Response to Argument/Amendment***

2. Applicant has amended claim 124 to include a print service station that comprises an input section, an image reading section and an image forming section. This is merely a printer or a copier. Printers and copiers are old and well known. Freedman's print service station is a company that provides printing services for a fee (column 5, lines 23-50; column 10, lines 15-35; column 11, lines 10-35; column 12, lines 43-46), hence it would have been obvious to provide users with the ability to "walk-in" and manually request printing services "on the spot". Applicant has also added limitations describing actions performed by a customer. However, the customer is not part of Applicant's claimed system that comprises a print service station and a data services station. Therefore, subsequent limitations that are based on, or depend from, a user "carrying a document" are mere intended use (MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987)). Claims 168-171 merely recite canceled limitations of claim 124 and have been addressed in previous rejections to claim 124.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 124, 126-128, 130-137, 139-141, 144, and 149-167 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 150 recites "information transmitted from the data managing section" however, claims 149, 147, 142 and 124, from which claim 150 depends are silent regarding said feature. There is insufficient antecedent basis for this limitation in the claim.

Claims 151-165 are also rejected as they depend from claims 150 and/or 151.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 124, 126-128, 130-137, 139, 140, 142, 144, 145, and 147-167 rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman, U.S. Patent No. 4,839,829 in view of Stefik et al., U.S. Patent No. 6,233,684.

As per claims 124, 126-128, 130, and 166-171, Freedman teaches a system for printing books (column 4, lines 36-42). Specifically, Freedman provides a print service station to allow customers to place and print an order (figures 1A-2B) for a fee (e.g. provides an estimate (column 10, lines 15-35 and 55-63; column 12, lines 42-50). Applicant has amended claim 124 to include a print service station that comprises an input section, an image reading section and an image forming section. This is merely a printer or a copier. Printers and copiers are old and well known. Freedman's print service station is a company that provides printing services for a fee (column 5, lines 23-50; column 10, lines 15-35; column 11, lines 10-35; column 12, lines 43-46), hence it would have been obvious to provide users with the ability to "walk-in" and manually request printing services "on the spot". Applicant has also added limitations describing actions performed by a customer. However, the customer is not part of Applicant's claimed system that comprises a print service station and a data services station. Therefore, subsequent limitations that are based on, or depend from, a user "carrying a document" are mere intended use (MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987)). Freedman also teaches a calculating section for calculating charges, based on a fee for using materials and/or printer (column 1, lines 30-41; column 10, lines 15-35 and 55-63; column 12, lines 42-

50) and providing a user with an estimate (column 10, lines 55-62). Therefore, as the "estimate" for print services is only an approximation the actual charge may be higher, lower, or equal and the customer would be billed accordingly.

Regarding the combining of the charges (claim 124), the Examiner takes Official Notice that consolidated billing is old and well known. For example, phone bills reflect fees and/or charges to a user by different parties or entities such as a local, long distance and international companies. Similarly, when a user uses a credit card at a POS, a first charge is calculated. This charge is transmitted back to the credit card company which then accumulates the sum of the users charges, adds other charges and presents a final charge to be paid by the user in full (American Express) or monthly (VISA, MasterCard). In either case, charges are passed up an hierarchy using an electronic network to an entity that is responsible calculating a final charge. However, Freedman does not specifically, teach a data service system. Stefik et al. teach a data service system, with a communication section, connected to a network having a storage section in which a plurality of data (e.g. book data) are stored in a plurality of data storing locations and a calculating section to calculate a payment to be charged in accordance with the printing result (abstract; figures 1, 2 and 5; column 5, lines 8-10 and 35-40; column 6, lines 50-55; column 9, lines 20-60; column 13, lines 10-19). Stefik et al. also teach data service charges based on at least one of a royalty, conversion a book into an electronic form and transmitting electronic

image data (figure 6; column 9, lines 20-40) and encrypting at least one of a data service or print service charge (figures 5-7). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Freedman and Stefik et al. in order provide for providing book data for a user to select from to print.

As per claims 142-156, Freedman teaches a system for requesting print services, such as services for printing letters and books (figure 1A; column 4, lines 25-43). Freedman also teaches providing customers with an estimated charge that comprises a cost summary of the different services provided by the system (column 10, lines 1-35 and 55-63; column/line 12/3-13/7) and a customer accepting the charges (column 13, lines 8-19). However, Freedman doesn't include a charge for providing book data. Stefik et al. teach charges associated with providing book data (figure 6; column 9, lines 20-40) and loan rights or "loaning" content to a user for limited time (column 5, lines 45-59). Stefik et al. also teach transmitting an order signal from customer to the data service system and the data service system (e.g. data managing section) transmitting job ID information and image data on the basis of the job ID information (e.g. license data, work ID, watermark, rights, ...etc.) to the printer station (and storage section in order to retrieve content) in response to the order (figures 5-7; column 8, lines 25-38; column 9, lines 40-64) and transmitting a data storing location (e.g. the file, watermark) to the print section (column 8, lines 5-38). Stefik et al. also teach a method and system for determining if a user has obtained the right

to print content. Therefore, the prior art at least suggest to one of ordinary skill correct identification of the printer, user and what was printed ('829, column/line 12/19-13/19; '684, figures 12 and 15). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Freedman and Stefik et al. in order to increase revenues by providing users with access to book data ('829, column 4, lines 36-42; '684, figures 1-4 and 16; column 5, lines 7-10) and to include a charge for said access in the Freedman system's print job cost estimate ('829, column 10, lines 55-63).

As per claims 157-161 and 163, Freedman teaches a system for printing books (column 4, lines 36-42) that includes a customer logging onto a data service system, a customer being provide with then approving a print job cost estimate and the system printing a book (figure 2A; column/line 12/19-13/19). Further, as the system is only providing a customer with an "estimate" (column 10, lines 55-63; column 12, lines 19-67), it is at least obvious that if the actual charge was higher or lower, the customer would be billed accordingly. While Stefik et al. also teach billing a user after it is verified that successful printing took place (column 13, lines 10-19). Therefore, to one of ordinary skill it would have been obvious to consider unsuccessful attempts as "trial" printing and to adjust the charge so as to not charge a user for an unsuccessful copy attempt (e.g. charging based on the printing result).



8. Claims 141, 162 and 164 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman, U.S. Patent No. 4,839,829 and Stefik et al., U.S. Patent No. 6,233,684 as applied to claims 140, 160 and 163 and in further view of Yoshiura et al., U.S. Patent No. 6,131,162.

As per claims 141, 162, and 164, Freedman teaches a system for printing books (column 4, lines 36-42). Stefik et al. teach a system for secured printing of content (e.g. intellectual property, rights, fees) using cryptography and watermarks that comprises sending the content to a user and/or printer over a network (abstract; figures 1, 2 and 5-7). However, neither Freedman nor Stefik et al. explicitly recite applying a digital signature to requested data using public key or other cryptographic scheme. Yoshiura et al. disclose a general teaching of authenticating a communication using digital signatures created by a public key cryptosystem (column/line 1/25-2/58). More Specifically, Yoshiura et al. teach a system for securing data where both provider and customer systems digitally sign data using public key cryptography (abstract; figures 2 and 5; column 6, lines 25-34; column 12, lines 12-28). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Freedman, Stefik et al. and Yoshiura et al. in order to protect against fraud and identify illegal copies of content ('684, column/line 10/1-11/23; column 12, line 10-51; '162, abstract; column 3, lines 14-28; column 11, lines 30-48).

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
c/o Technology Center 2100  
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application  
should be directed to the Group receptionist whose telephone number is (703)

368-1113.



Calvin Loyd Hewitt II

April 11, 2005